

REMARKS/ARGUMENTS

The Applicant respectfully submits the following Remarks/Arguments:

I. CLAIM REJECTIONS UNDER 35 USC 102(b)

The Examiner has rejected claims 1-4, 7, 8, 10, 11, 13-15, 17 and 18 under 35 USC 102(b) as being anticipated by Malone et al., U.S. Pat. No. 5,859,588. 35 USC 102(b) states: "A person shall be entitled to a patent unless- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." Therefore, the above mentioned claims will be unpatentable if each element of the respective claims is disclosed or taught by Malone et al.

Malone et al. discloses a personal safety device comprising a handbag with pepper spray and air siren canisters stored therein. Malone et al., U.S. Pat. No. 5,859,588 Abstract lines 1-2. The invention relates to a women's purse equipped with pepper spray and air siren devices. Malone et al. at col. 1 lines 10-11. On the interior of the purse a rigid board with brackets, including a canister base, is riveted to the purse. The purpose of the brackets is to securely hold the canisters in place. Malone et al. at col. 2 lines 20-25. The means for activating the canisters is located in a "handle of the handbag." Malone et al. col. 4 lines 6-8.

Although the patent granted to Malone et al. shares some common features with Applicant's invention, there are many specific differences that prevent Malone et al. from serving as an anticipatory prior art reference. The Examiner has referenced the purse disclosed by Malone et al. as meeting the housing member element claimed by Applicant.

If a housing member is disclosed by Malone et al., it is most closely met by the rigid board, plastic bracket, and canister base assembly that is attached to the interior of the purse by rivets. If this assembly was viewed apart from the purse, it would only lack the remaining housing walls to closely resemble Applicant's invention. However, Malone et al. also discloses a secondary outer housing, i.e. the purse, within which to integrate the inner support assembly. The rigid board, brackets and base assembly of Malone et al. do not meet the housing member claim of Applicant's invention by itself because it does not fully house the canisters. Placing the assembly within a secondary, outer housing does not rectify its inability to meet this claim requirement. As a result, the housing member claim element of Applicant's invention is not disclosed by Malone et al. by either the purse, or its interior canister retaining assembly. Therefore, claim 1 of Applicant's invention is not anticipated by Malone et al.

Claims 2-4, 7, 8, 10, and 11, therefore, will also not be anticipated by Malone et al. as they all properly depend from claim 1. However, some of the rejected claims have additional justifications for avoiding rejection, apart from the dependency on claim 1.

Much of the logic of the Examiner's rejections flows from an assumption that the handle of the purse is part of the purse itself. However, a handle is merely a means by which to carry a purse, and would not be considered part of the ordinary housing portion of woman's handbag because the handle does not perform any housing functions. This fact is at odds with the Examiner's rejections.

For example, Applicant's claim 2 is rejected based on the contention that the housing member (purse) disclosed by Malone et al. has a first aperture 18 for allowing

release of the repellant spray. As noted above, Malone et al. claims "said handle of the handbag having a hole through which pepper spray is dispersed." Malone et al. col. 4 lines 11-12.

This distinction is not merely semantics, rather it illustrates that the handle is not part of the handbag. It also illustrates that the handle of the handbag has the aperture for dispersing the repellant, and it is not the handbag itself that has the aperture as claimed by the Examiner. Therefore, even if the purse was viewed as meeting the housing member element, the aperture is not part of the housing. This point is further illustrated when contrasted with the limitation concerning the second aperture for the sound generating device, which is located on the purse. The Examiner's rejection of Applicant's claim 3 states that the housing member of Malone et al. has a second aperture for allowing emission of the sound generated from the sound device member. According to the disclosure provided by Malone et al., that limitation discloses "the *handbag* having a vent," which is clearly different than the *handle* of the handbag as claimed in a previous limitation. Malone et al. col. 4 line 13 (emphasis added).

Therefore, it should be seen that even if the handbag is considered as meeting the housing member element of Applicant's invention, it can not be rightly argued that the housing member of Malone et al. has a first aperture for dispersing repellant spray. The first aperture disclosed by Malone is located within the handle of the handbag, not within the handbag itself. Accordingly, claim 2 is not anticipated by Malone et al. because the housing member does not include a first aperture for dispersing repellant.

Further, there exists independent justifications sufficient to overcome the Examiner's rejection of claim 7. Applicant's claim 7 includes the limitation of an actuator integrated with the housing member. As mentioned above, Malone et al. discloses a separate handle, in addition to the handbag. The actuating means disclosed by Malone et al. is "located in a handle of the handbag." Malone et al., col. 4 lines 6-8. Applicant's invention claims an actuator that is integrated with the housing member, not in a peripheral component, such as a handle. Although the handle of the handbag disclosed by Malone et al. may be connected to the handbag, it can not be said that this indirect connection integrates the actuator within the handbag. As a result, Applicant's claim 7 is not anticipated by Malone et al. because the actuator disclosed by Malone et al. is not integrated with the housing member. Accordingly, Applicant's claim 7 should be allowed.

With regard to the Examiner's rejection of Applicant's claim 8, the Examiner has stated that Malone et al. discloses that the repellant is a noxious gas. However, the citation that the Examiner notes (col. 2, lines 16-18) reads as follows: "A chamber 19 is located at the base of the handle distal end. This chamber 18 opening allows a pepper spray stream to pass." Nowhere in Malone et al. is there reference to a "noxious gas," or of any type of gas at all. Malone et al. claims, and the specification supports, only the use of "pepper spray." Various citations on the Internet may be found discussing the make-up of pepper spray. The following description is one example:

OC is oleoresin capsicum, which is extracted from chili peppers and is commonly called Pepper Spray. This product is the most widely sold today and the spray of choice for police since 1977. Pepper spray is generally regarded to be the most distressing to experience, but it must be sprayed directly in the eyes

or inhaled to be effective. *The product is an oily liquid* not very soluble in water. McGoe, Chris E., http://www.crimedocto.com/self_defense_1.htm, Last Updated 4/30/2004 (emphasis added).

A similar definition can be found in the dictionary that defines "pepper spray" as:
"a nonlethal aerosol spray made with the pepper derivative oleorsein capiscum; used to cause temporary blindness and incapacitate an attacker; also used as a bear deterrent."
<http://wordnet.princeton.edu/cgi-bin/webwn2.0?stage=1&word=pepper+spray>, Wordnet A Lexical Database For the English Language, Last Visited June 01, 2004.

Therefore, it is seen that pepper spray is not a gas at all, but a liquid. As a result, contrary to the Examiner's assertion, Malone et al. does not disclose that the repellant is a noxious gas. Accordingly, Applicant's claim 8 is not anticipated by Malone et al. and should be allowed.

The Examiner has also rejected claims 10 and 11 as being anticipated by the disclosure of Malone et al. Because the two claims and respective rejections are closely connected, both will be dealt with simultaneously to avoid repetitious argument. The Examiner's rejections of claims 10 and 11 both state that the Malone et al. discloses a sound generating member comprised of a compressed gas container coupled to a horn and a whistle, respectively. However, nowhere in the Examiner's citation (col. 2, lines 25-44) is there reference, explicitly or implicitly, to either compressed gas, whistles or horns. Malone et al. discloses merely an "air siren canister," an "air siren," and a "piercing sound." Malone et al. at col. 2 lines 25-44. Applicant's sound generating member contains such details in the specification as "a compressed gas container 8 coupled to a horn 9 via a second tube." Applicant's Detailed Description page 3 para. 17.

Malone et al. does not disclose the use of a second tube, nor does it disclose a compressed gas container coupled to a horn. Regardless of how the air siren of Malone et al. generates its "piercing sound," it does not disclose the specific limitations found in Applicant's invention. Therefore, Malone et al. can not be said to anticipate Applicant's claim 10. The same arguments are equally applicable to Applicant's claim 11, substituting a whistle for the horn. Accordingly, neither claim 10 nor claim 11 are anticipated by Malone et al. and should be allowed.

The rejections for claims 13, 15, 17 and 18 are similarly rebutted as mentioned above, and said rebuttal arguments should be considered equally applicable to the respective claims (i.e. the purse does not function as a housing member; the housing member does not contain the first aperture in contrast to the second aperture; the actuator is integrated in the handle of the handbag, not in the housing member; the repellant is pepper spray, not a noxious gas; the sound generating member is not disclosed as compressed gas coupled to a horn or a whistle).

II. CLAIM REJECTIONS UNDER 35 USC 103

In response to the Examiner's rejection under 35 USC 103, Applicant first notes that in rejecting the claims, the Examiner merely references a few specific claim limitations, but does not show, or even argue, that Applicant's invention as a whole would be obvious in light of the cited prior art patents. For example, in the rejection of claims 5 and 6, the Examiner argues merely that it would be obvious to substitute the switch of Keeter, U.S. Pat. No. 5,867,099 with the switch of Malone et al. Applicant is left to determine whether the additional claim limitations of Applicant's claim 1, from which

claim 5 and 6 both depend, are obvious over Malone et al. in view of Keeter in the Examiner's opinion.

By way of illustration, Applicant respectfully contends that the housing member of Applicant's claim 1 is not rendered obvious by the housing member disclosed by Malone et al. for similar reasons advanced above as to why Malone et al. does not anticipate this claim limitation. As a result, it would be irrelevant if the switch of Malone et al. could be replaced by the switch of Keeter, if Malone et al. does not render the other claim elements obvious as well.

Applicant would likewise advance arguments in support of a finding of nonobviousness for the other claim elements, had those elements been noted by the Examiner. Applicant respectfully argues that this same line of reasoning applies to the Examiner's rejections under 35 USC 103 of claims 6 and 16, and claims 12 and 19. Without specific references as to which elements of Applicant's invention are deemed obvious in addition to those cited by the Examiner, Applicant is unable to even begin to forward any logical arguments with respect to the other claim limitations. Any attempt to do so, would involve pure conjecture at best.

However, Applicant will address why the specific claim elements argued by the Examiner are not obvious, but Applicant does not waive the right to show that the other limitations found in Applicant's invention are not obvious, should the Examiner deem them to be so. If the Examiner does not allege that the unreferenced limitations are obvious in view of the cited prior art patents, Applicant contends that Applicant's

invention, and respective claims, are not obvious because the subject matter as a whole cannot be said to be obvious to a person of ordinary skill.

The Examiner argues that both Keeter and Malone et al. teach an alarm system to deter an attacker. Before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to combine those references. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568 (1996).

Malone et al. discloses a personal protection device carried by a user, designed to surprise an attacker, thereby allowing the victim time to escape or summon help. Malone et al., U.S. Pat. No. 5,859,588 col. 1 lines 34-37. Keeter discloses a motion sensing lighting and alarming system. Keeter, U.S. Pat. No. 5,867,099 col. 3 lines 39-40. The alarming system disclosed by Keeter includes a mounting base, and includes a "passive infrared motion detector." Keeter at col. 4 lines 44-46. Therefore, Keeter teaches a passive alarm system designed for mounting upon a structure.

Applicant's invention is designed to be carried by a user, and unlike the device disclosed by Malone et al., has the added deterrent effect that a potential attacker will not be misled into believing that the user is carrying a non-threatening device, such as a purse. The device disclosed by Keeter does not provide any offensive capabilities such as a spray. Additionally, the device disclosed by Keeter is designed to provide a passive alarm system for a structure. Although the two devices can both emit sound waves as an alarm, they do not both relate to personal protective devices. Malone et al. can clearly be seen as relating to personal protective devices, but Keeter's connection to personal

protection is tenuous at best. The fields are different enough that one skilled in either of the arts would not be motivated to attempt any combination of the two. Any attempt at combining them would not only fail to render Applicant's invention obvious, the resulting device would be inoperable. Because of the differences inherent in the two fields of art, and the inescapable conclusion that the switch of Keeter would render the combination inoperable, the cumulative differences between the combination and Applicant's invention result in the conclusion that Applicant's invention would not be obvious to one of ordinary skill in the art.

The Examiner has rejected claims 5 and 6 as being unpatentable over Malone in view of Keeter. The Examiner notes that Malone et al. discloses an actuator that activates both spray and sound simultaneously. The Examiner cites Keeter as disclosing a three position mini-slide switch that would enhance the system of Malone et al. by giving the user an option of selecting the particular mode, as desired. Therefore, the Examiner concludes that the combination of Malone et al. and Keeter would render Applicant's invention obvious. The Examiner argues specifically that substituting the switch 28 of Keeter with the switch 12 of Malone et al. will render Applicant's invention obvious, and therefore, unpatentable.

The switch referenced by the Examiner is a "three position double pole mini-slide switch." Keeter at col. 4 lines 17-18. As disclosed by Fig. 6, the switch disclosed by Keeter is part of an electrical circuit that when closed, will complete the circuit for either the lights, the audible alarm, or both. Keeter at Fig. 6.

The switch disclosed by Applicant's invention is a manually operated, slidable switch that requires the physical depression of an actuator pad. Chiapperini, U.S. Pat. Appl. No. 10/065,022 para. 17 and Fig. 1. The switch disclosed by Applicant will result in the depression of subsequent actuator pads that actuate either spray, sound, or both simultaneously. Chiapperini at para. 17 and Fig. 1.

It should be clear that substituting the switch of Keeter for the switch of Malone et al. will result in a personal protection device that is inoperable. There is no electrical component disclosed within Malone et al. that will operate with the switch of Keeter. A device resulting from the combination of two or more patents that results in an inoperable product can not be said to render Applicant's invention obvious. Therefore, the combination of Malone et al. and Keeter will not produce a combined teaching that will result in making Applicant's invention obvious to one of ordinary skill in the art at the time the invention was made. As a result, claims 5 and 6 are not unpatentable under 35 USC 103(a) in light of Malone et al. in view of Keeter.

The Examiner has also rejected claims 9 and 16 as being unpatentable over Malone et al. arguing that "it would have been obvious to the skilled artisan to readily recognize that pepper spray is a mixture of noxious gases." Examiner's Office Action, par. 5. However, as stated previously, this is not the case.

Malone et al. claims, and the specification supports, only the use of "pepper spray." Various citations on the Internet may be found discussing the make-up of pepper spray. The following description is one example:

OC is oleoresin capsicum, which is extracted from chili peppers and is commonly called Pepper Spray. This product is the most widely sold today and

the spray of choice for police since 1977. Pepper spray is generally regarded to be the most distressing to experience, but it must be sprayed directly in the eyes or inhaled to be effective. *The product is an oily liquid* not very soluble in water.

McGoey, Chris E., http://www.crimedoctor.com/self_defense_1.htm, Last Updated 4/30/2004 (emphasis added). A similar definition can be found in the dictionary

that defines "pepper spray" as: "a nonlethal aerosol spray made with the pepper derivative oleorsein capiscum; used to cause temporary blindness and incapacitate an attacker; also used as a bear deterrent."

<http://wordnet.princeton.edu/cgi-bin/webwn2.0?stage=1&word=pepper+spray>, Wordnet A Lexical Database For the English Language, Last Visited June 01, 2004.

Therefore, it is seen that pepper spray is not a gas at all, but a liquid. As a result, pepper spray is not a mixture of noxious gases, therefore, it would not be obvious to the skilled artisan to substitute a mixture of noxious gases for the pepper spray disclosed by Malone et al. As a result, claims 9 and 16 are not obvious in light of Malone et al., and should be allowed.

The Examiner also has rejected claims 12 and 19 as being unpatentable over Malone et al. in view of Masi et al., U.S. Pat. No. 5,517,180. Masi et al. teaches an alternative use of the claimed device in deterring vicious dogs by providing a high pitched frequency. Masi et al. col 9, lines 14-18. Applicant's invention as disclosed in claims 12 and 19, claims a sound generating member that "has means for emitting sounds waves that are audible to animals and not audible to humans." Chiapperini at Claims 12 and 19.

The key difference between the teaching of Masi et al. and Applicant's invention is that Masi et al. only teaches a high pitched frequency, not a sound that is audible to animals and inaudible to humans. The sound waves emitted by Applicant's invention may or may not be a high pitched frequency, the only limitation is that it be audible to animals and not to humans. Masi et al. does not teach a device that emits sound waves that are inaudible to humans. The high pitched frequency disclosed by Masi et al. could deter dogs while still being audible to humans. Masi et al. does not disclose any type of instruction as to how high a frequency would suffice to deter dogs, nor does Masi et al. indicate whether the high pitched frequency would be within the hearing range of humans or not. As a result, the only thing that Masi et al. has in common with Applicant's invention with respect to the sound waves is that they are emitted from the device. Therefore, a significant difference exists between the sound waves emitted from the two devices; and this difference is so significant that it removes any possibility that Applicant's invention could be rendered obvious under 35 USC 103.

Therefore, reconsideration and further examination is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

In the event that an extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to

Appl. No. 10/065,022
Response dated June 02, 2004
Reply to Office action of December 04, 2003

make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 12-0115.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Patrick D. Archibald, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

June 2, 2004 Patrick D. Archibald
Date Patrick D. Archibald
Attorney for the Applicant
Reg. No. 52,464

Patrick D. Archibald
Lambert & Associates
92 State Street
Boston, MA 02109
617-720-0091